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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/753,251

01/08/2004

David H. Hanes

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EXAMINER

ADEGEYE, OLUWASEUN

ART UNIT

PAPER NUMBER

2481

NOTIFICATION DATE

DELIVERY MODE

11/26/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/753,251	Applicant(s) HANES, DAVID H.	
	Examiner OLUWASEUN A. ADEGEYE	Art Unit 2481	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/15/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/08/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 09/15/2010 have been fully considered but they are not persuasive.

In re pages 8 and 9 of the applicants' argument, applicants argue that the cited Kitamura reference only discloses a single rule unlike the claimed rule set that includes at least two rules (MPEG and compatibility rules) with each rule pertaining to a different type of MPEG encoder.

In response, the examiner respectfully disagrees. The cited Kitamura reference discloses a plurality of transcoders which all contain at least one decoder therefore there is a plurality of decoders (see column 16, lines 62 – 65.”.... To explain the functions of the transcoder 101, three transcoders having functions similar to those of the transcoder 101, are assumed to be connectively located before the transcoder 101.....”). Therefore each time the bit stream passes through a transcoder, a set of parameters are generated for example column 17 lines 30 – 40 discloses encoding parameters generated during the 3rd generation whereas column 17, lines 44 – 52 discloses encoding parameters generated during the first, second and third generation. All these information about past encoding parameters are stored in a history stream (see column 17, lines 60 – 67). Therefore each time the bit stream passes from one transcoder to the next, the stored encoding parameters are checked to see whether they need to be changed or not based on the operator or the host computer (see column 20, lines 50 – 57). From the cited paragraphs it is easy to see that each time a

bit stream passes through a transcoder, a set of parameters are checked to see whether they need to be transcoded or not based on what the operator desires.

Therefore when the bit stream goes from one transcoder to the next, a set of parameters are checked e.g. sequence_header (see column 17, lines 35) this is the first rule set then the bit stream goes to the next transcoder, a set of parameters are also checked e.g. group_of_pictures_header (see column 17, lines 36 - 37) which is the second rule set.

In page 9 of the applicants arguments, applicants agree that there is at least 1 rule set in the Kitamura reference but since the Kitamura reference discloses 4 transcoders (see column 16, lines 62 – 64), the examiner interprets this to include at least 4 rule sets and at least 4 decoders because based on what an operator or host computer desires in terms of for example bit rate and GOP structure, the encoding devices encodes the video data (see column 20, lines 50 - 57). Each time the above process occurs, the examiner interprets that to be a separate rule set.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 9 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying

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subject matter (such as an article or material) to a different state or thing. While the instant claims recite a series of steps or acts to be performed, the claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, a method of retrieving a rule set, reading a portion of a file, comparing the portion of the file with the rule set and determining whether the file violates a rule set is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine.

Claims 18 - 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Said claim discloses a "computer-readable medium" (line 1). Both said claim and the respective specification (p. 9, lines 8 - 10) fail to disclose whether said "computer-readable medium" is limited to a non-transitory medium or transitory propagating signal. Reading said claim under the broadest reasonable interpretation "computer-readable medium" is considered to read on a transitory propagating signal. See the Subject Matter Eligibility of Computer Readable Media memo dated February, 23 2010 (1351 OG 212). A claim directed to only signals per se is not a process, machine, manufacture, or composition of matter and therefore is not directed to statutory subject matter. See MPEP § 2106. Thus, both said claim and said specification fail to define said "computer readable medium" to be statutory media.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 – 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitamura (US 7,236,526 B1).

As to **claim 1**, Kitamura discloses a method of analyzing a moving pictures expert group (MPEG)-formatted video/audio file (see column 17, lines 39 – 43), comprising:

retrieving a rule set that includes an MPEG rule and a compatibility rule, said MPEG rule defining a format requirement for the file to be decoded by a first type of MPEG-capable decoder, and the compatibility rule defining a format requirement for the file to be decoded by a second type of MPEG-capable decoder (each time the bit stream passes through a transcoder, a set of parameters are generated for example column 17 lines 30 – 40 discloses encoding parameters generated during the 3rd generation whereas column 17, lines 44 – 52 discloses encoding parameters generated during the first, second and third generation. All these information about past encoding parameters are stored in a history stream (see column 17, lines 60 – 67). Therefore each time the bit stream passes from one transcoder to the next, the stored encoding parameters are checked to see whether they need to be changed or not based on the operator or the host computer (see column 20, lines 50 – 57). From the

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cited paragraphs it is easy to see that each time a bit stream passes through a transcoder, a set of parameters are checked to see whether they need to be transcoded or not based on what the operator desires. Therefore when the bit stream goes from one transcoder to the next, a set of parameters are checked e.g. `sequence_header` (see column 17, lines 35) this is the first rule set then the bit stream goes to the next transcoder, a set of parameters are also checked e.g. `group_of_pictures_header` (see column 17, lines 36 - 37) which is the second rule set.

Since the Kitamura reference discloses 4 transcoders (see column 16, lines 62 – 64), the examiner interprets this to include at least 4 rule sets and at least 4 decoders because based on what an operator or host computer desires in terms of for example bit rate and GOP structure, the encoding devices encodes the video data (see column 20, lines 50 - 57). Each time the above process occurs, the examiner interprets that to be a separate rule set.

reading a portion of the file (see column 21, lines 42 – 44. the above cited paragraph discloses checking the picture type of a past encoding process);

comparing the portion of the file with the MPEG and compatibility rules contained in the rule set (see column 21, lines 36 – 57.”....If the picture type specified for the reference picture for the fourth-generation encoding process is different from all picture types for the past encoding processes....”); and

determining whether the file violates any of the MPEG and compatibility rules contained in the rule set (see column 21, lines 36 – 57.”....If the picture type specified for the reference picture for the fourth-generation encoding process is different from all

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picture types for the past encoding processes, the controller 70 carries out a “normal encoding process.”).

As to **claim 2**, Kitamura the method according to claim 1, wherein the MPEG rule comprises a parameter for addressing the portion of the file (see column 17, lines 26 – 44, column, column 20, lines 50 – 57, column 21, lines 14 – 57. From the above cited columns the defined rule is the bit rate and the GOP structure. From the above cited column, if the host computer operates with a different bit rate or GOP structure that is different from the previous three, transcoder 101 will transcode the bit stream to the format required by the operator or the host computer.).

As to **claim 3**, Kitamura discloses the method according to claim 2, wherein the parameter specifies a bit rate of the file (see column 17, lines 26 – 44, column, column 20, lines 50 – 57, column 21, lines 14 – 57. From the above cited columns the defined rule is the bit rate and the GOP structure. From the above cited column, if the host computer operates with a different bit rate or GOP structure that is different from the previous three, transcoder 101 will transcode the bit stream to the format required by the operator or the host computer)

As to **claim 4**, Kitamura discloses the method according to claim 1, wherein at least one of the rules comprises at least one parameter logically defining a standardized format requirement (see column 17, lines 42 – 43).

As to **claim 5**, Kitamura discloses the method according to claim 1, wherein at least one of the rules comprises at least one parameter logically defining a MPEG format requirement (see column 17, lines 42 – 43).

As to **claim 6**, Kitamura discloses the method according to claim 1, wherein the compatibility rule comprises at least one parameter logically defining a digital versatile disc (DVD) format requirement (see column 17, lines 25 – 43. Line 43 discloses MPEG2).

As to **claim 7**, Kitamura discloses the method according to claim 1, wherein reading a portion of the file comprises locating a sequence header of the file (see column 17, line 35).

As to **claim 8**, Kitamura discloses the method according to claim 1, wherein comparing the portion of the file comprises determining whether the file comprises a group of pictures (GOP) header (see column 17, lines 36 - 37).

As to **claim 9**, Kitamura discloses the method according to claim 1, further comprising transcoding the file upon determining the file violates any of the rule (see column 17, lines 26 – 44, column, column 20, lines 50 – 57, column 21, lines 14 – 57. From the above cited columns the defined rule is the bit rate and the GOP structure. From the above cited column, if the host computer operates with a different bit rate or GOP structure that is different from the previous three, transcoder 101 will transcode the bit stream to the format required by the operator or the host computer).

As to **claims 10 – 17**, grounds for rejecting claims 1 - 9 apply to claims 10 - 17 in its entirety. Figure 15 discloses the transcoder (101), computer (100) and decoder (102).

As to **claim 18**, this is a computer readable medium claim corresponding to the method claim 1. Therefore, claim 18 is analyzed and rejected as previously discussed

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with respect to claim 1. Column 65, lines 22 – 27 discloses computer programs corresponding to the method of claim 1.

As to **claims 19 – 14**, grounds for rejecting claims 1 - 9 apply to claims 19 - 24 in its entirety.

As to **claims 25**, grounds for rejecting claim 1 apply to claim 25 in its entirety. Figure 15 discloses the transcoder (101), computer (100) and decoder (102).

As to **claims 26**, grounds for rejecting claim 9 apply to claims 26 in its entirety.

As to **claim 27**, Kitamura discloses the method of claim 1 wherein:

the MPEG rule specifies a maximum bit rate value (see column 21, lines 19 – 23.”...The controller 70 also receives information on a target bit rate....”) and a location within a sequence header of the file at which a bit rate encoded in the file is located (column 21, lines 24 - 27 discloses history information from the history information separating device with has history information on the past encoding parameters such as the sequence header (see column 17, line 35)), and

the compatibility rule specifies that a GOP header must be present in the file (see column 17, lines 36 – 37).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUWASEUN A. ADEGEYE whose telephone number is (571)270-1711. The examiner can normally be reached on Monday - Friday 7:30 - 5:00 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/19/2010

/O.A/

/Peter-Anthony Pappas/
Supervisory Patent Examiner, Art Unit 2481